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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/823,086 | 03/29/2001 | Himiko Takayama | T-5884 | 6983 |

7590 03/19/2004
Chevron Corporation
Law Department, Patent and Licensing Unit
P.O. Box 6006
San Ramon, CA 94583-0806

EXAMINER

MCAVOY, ELLEN M

| ART UNIT | PAPER NUMBER |
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1764

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,086

Applicant(s)

TAKAYAMA ET AL.

Examiner

Ellen M McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/25/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (4,634,543).

Okada et al ["Okada"] disclose a hydraulic fluid composition for use in a hydraulic shock absorber which comprises (a) a lubricating base oil, (b) 10 to 1,000 ppm, as calculated as boron, of a boron-containing compound, and (c) 100 to 3,000 ppm, as calculated as phosphorus, of phosphoric acid ester and/or phosphorous acid ester. See column 1, lines 10-60. The lubricating base oils include petroleum and synthetic lubricating oils having a viscosity at 40°C of from 5 to 50 cSt. The boron-containing compounds include borated dispersants such as succinimides. See column 1, line 63 to column 3, line 32. The phosphoric acid esters are set forth in column 3, lines 37-54, and the phosphorous acid esters are set forth in column 3, lines 56-62. In addition, Okada teaches that the reaction products of phosphoric acid esters and/or phosphorous acid esters and amine compounds can be used. See column 3, lines 65-67. The examiner is of the position that the hydraulic fluid composition of Okada meets the limitations of the above rejected claims when alkenyl succinimide component (c) is borated which is taught by applicants on page 9 of the specification; that a preferred derivative of alkenyl succinimide is a borated derivative. The examiner is of the position that the closest prior art example in Okada is

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Example 4 set forth in Table 1. Example 4 is an oil composition containing 93.8 % by weight of a petroleum lubricating base oil having a viscosity of 15 cSt at 40°C, 0.5 % of boron-containing compound A, 0.5% of boron-containing compound B, 0.5% of a phosphorous acid ester and 0.5% of a phosphoric acid ester, and other additives including a lubricating agent, a viscosity index agent and an antioxidant. The composition has a phosphorus content of 685 ppm. Applicants' open-ended claim language "comprising" allows for the addition of other additives to the composition.

Claim Rejections - 35 USC § 103

Claims 1-36 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Miyagawa et al (5,536,423) or Miyagawa et al ((5,561,104).

The Miyagawa et al ["Miyagawa"] references disclose a hydraulic working oil composition for buffers which comprises a base lubricating oil and (A) at least one phosphorus-containing compound selected from the group consisting of (a) a phosphoric acid ester, (b) a phosphorous acid ester, and (c) a salt of the phosphoric acid ester (a) and/or the phosphorous acid ester (b) an aliphatic monoamine having 8-22 carbon atoms; and (B) at least one nitrogen-containing compound selected from an aliphatic polyamine and a salt thereof with an aliphatic acid. See column 2, lines 5-50 in '423 and column 2, line 13 to column 3, top in '104. The base lubricating oil includes both mineral oil and synthetic oil and preferably has a viscosity in the range of 8-60 cSt at 40°C. Both references teach the addition of other additives to the composition including ashless dispersants such as succinic imide, succinic esters and benzyl

amine. See column 13, lines 9-32, and claim 20 of '423 and see column 6, lines 4-5 of '104.

The examiner is of the position that the Miyagawa references also clearly meet the limitations of the above rejected claims when component (A) is (c) a salt of phosphoric acid ester (a) and a salt of phosphorous acid ester (b) and an aliphatic monoamine having 8-22 carbon atoms.

Applicants' open-ended claim language "comprising" allows for the addition of other additives to the composition such as component (B), at least one nitrogen-containing compound.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

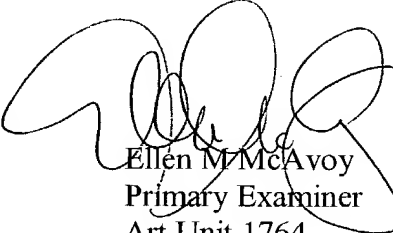
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M. McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
March 13, 2004